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Commissioner for Patents
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Request for Continued Examination (RCE) Transmittal

Docket No.: 55409US002

RCE/1700
#11
8/18-03
RECEIVED
AUG 18 2003
TC 1700

First Named Inventor: Reid, Thomas J.

Application No.: 09/678570

Group Art Unit: 1733

Filed: October 3, 2000

Examiner: John J. Gallagher

Title: METHOD OF FINISHING A WOOD SUBSTRATE

This is a Request for Continued Examination (RCE) under 37 CFR § 1.114 of the above-identified application.

1. Submission required under 37 CFR § 1.114

- a. ☐ Previously submitted
- i. ☐ Consider the amendment(s)/reply under 37 CFR § 1.116 previously filed on
(Any unentered amendment(s) referred to above will be entered)
- ii. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on
- iii. ☐ Other
- b. ☒ Enclosed
- i. ☒ Amendment/Reply
- ii. ☐ Affidavit(s)/Declaration(s)
- iii. ☐ Information Disclosure Statement (IDS)/Supplemental IDS
- iv. ☐ Other

2. ☒ A Request for Extension of Time is being filed concurrently

3. Fees (The RCE fee under 37 CFR § 1.17(e) is required by 37 CFR § 1.114 when the RCE is filed.)

- a. ☒ The Director is hereby authorized to charge the following fees or credit any overpayments to:
Deposit Account No. 13-3723. **A duplicate copy of this letter for fees processing is enclosed.**
- i. ☒ RCE fee required under 37 CFR § 1.17(e)
- ii. ☐ Other

Respectfully submitted,

August 11, 2003

Date

By:

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Patent
Case No.: 55409US002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor: REID, THOMAS J.
Application No.: 09/678570 Group Art Unit: 1733
Filed: October 3, 2000 Examiner: John J. Gallagher
Title: METHOD OF FINISHING A WOOD SUBSTRATE

RESPONSE

Mail Stop: RCE
Commissioner for Patents
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Alexandria, VA 22313-1450

CERTIFICATE OF MAILING

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8-11-03
Date

Kimberly A. Hayes
Signed by: Kimberly A. Hayes

Dear Sir:

This paper is submitted in lieu of an Appeal Brief and in response to the Office Action dated November 4, 2002. A petition for Extension Of Time Under 37 CFR § 1.136(a) and authorization to charge the extension of time fee to Assignee's deposit account is included with this Amendment. Please charge any fees due, or credit any overpayment to Deposit Account No. 13-3723.

Reconsideration of the application is respectfully requested.

35 U.S.C. 112:

Claim 17 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

The Office Action states that this rejection is adhered to essentially for the reasons of record. (see paragraphs 1 and 2(c) of the last Office Action). The Office Action further states that Applicants' contentions as set forth in the amendment at page 2 line 22 thru page 3 line 10 have been noted; however, applicants' specification is seen not to establish (i.e., to give no indication) that the TRADEMARK VARNISH material employed and recited in conjunction with the Examples (N.B. page 12 lines 7-10) corresponds to (i.e. is the same as) the coating material disclosed at page 2 line 29 thru page 3 line 2 of the specification.

The reasons of record in paper number 4 state in part that: "There is apparently no support in the specification for a process which employs a COMBINATION of steps as set forth in steps (c) and (d) as recited in claim 17, the entire tenor of applicants' specification (N.B. page 2 line 29 thru page 3 line 2 and page 11 lines 14-15) apparently indicating that EITHER BUT NOT BOTH of the aforementioned steps is employed in any one process.

Applicants cannot agree with the position taken with respect to claim 17. For example, the present specification states at page 11, beginning at line 8 that:

"In a preferred embodiment, the wood surface is finished with from 1 to 4 coats, preferably 3 to 4 coats, of a liquid varnish material such as that commercially available under the trade designation "Z SPAR CAPTAINS'S VARNISH" (available from Kop-Coat Inc., Rockaway NJ) prior to application of the finishing film.

After preparing the wood substrate, the finishing film is then adhered to the surface of the substrate. In one variation of the method of the present invention, the surface of the wood substrate is first wet with a wetting solution prior to application of the finishing film."

This portion of the text provides clear and unambiguous support for a process including a combination of steps (c) and (d).

In addition, the Examiners' attention is directed to Example 1 of the specification. Example 1 states at page 12, lines 1-3 that "Samples of wood substrate were first varnished with 4 layers of varnish (commercially available under the trade designation "Z SPAR CAPTAIN'S VARNISH"

from Kop-Coat Inc., Rockaway NJ)." Example 1 further states at page 12, lines 21 that "The finishing film was applied to the substrate using a wet application method."

The Office Action states that "...applicants' specification is seen not to establish (i.e., to give no indication) that the TRADENAME VARNISH material employed and recited in conjunction with the Examples (N.B. page 12 lines 7-10) corresponds to (i.e., is the same as) the coating material disclosed at page 2 line 29 thru page 3 line 2 of the specification."

Applicants cannot agree. The specification at page 11, lines 1-25 provides clear support that "Z SPAR CAPTAIN'S VARNISH" can be used to coat the wood substrate prior to the application of a finishing film (step (c)), and that the finishing film may be applied using a wet process (step (d)). Applicants submit that one of skill in the art would clearly understand that "Z SPAR CAPTAIN'S VARNISH" is an example of the materials that could be used in step (c) of the method of claim 17. Accordingly, the specification provides support for pending claim 17.

In view of the foregoing, the rejection of claim 17 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention has been overcome and should be withdrawn.

35 U.S.C. 102:

Claims 1, 8 and 13-14 stand rejected under 35 U.S.C. 102(b) as being anticipated by Hoogstoel (U.S. Patent No. 3,607,540).

Hoogstoel reports a method of applying a sheet material having a pressure sensitive adhesive layer on one surface thereof to a substrate. The method includes the steps of: (a) forming on the surface of the substrate to which the pressure sensitive adhesive coated sheet material is to be applied a temporary liquid barrier layer, the barrier layer being a nonsolvent for the pressure-sensitive adhesive layer and being of poor cohesive strength relative to the adhesive layer; (b) applying said sheet material to said liquid barrier with the pressure sensitive adhesive in contact with the liquid barrier; (c) sliding the sheet material whereby the barrier layer shears and permits

the sheet material to be properly positioned relative to the substrate; and (d) keeping the sheet material in the proper position while the temporary liquid barrier dissipates by evaporation or absorption thereby fixing said sheet material in position relative to the substrate with the adhesive surface in direct contact with the substrate.

Hoogstoel does not teach or suggest applicants' claimed method of finishing a wood surface for exterior exposure of the wood, which includes the steps of:

- (a) providing a finishing film material in the form of a sheet, said finishing material comprising:
 - (i) a flexible polymeric sheet material having a first major surface and a second major surface;
 - (ii) a pressure sensitive adhesive layer covering at least a portion of the first major surface of the sheet material;
- (b) providing a wood substrate having a surface; and
- (c) adhering the adhesive layer of the finishing film material to the surface of the wood by placing the adhesive layer of the finishing film in contact with the surface of the wood substrate and optionally applying pressure over at least a portion of the second major surface of the polymeric sheet material.

The method of Hoogstoel is directed to applying adhesive coated wallpaper to a substrate. Hoogstoel does not teach or suggest a method of finishing a wood substrate with a polymer sheet material for exterior exposure of the wood. Although Hoogstoel reports that the substrate may be wood, the outcome of the method of Hoogstoel is to apply wallpaper in order to completely cover the wood substrate. By contrast, Applicants' claimed method is a method of finishing the wood substrate so that the wood can be visible and exposed to outdoor environmental conditions. That is, the wood is not covered but is exposed and can be viewed by an observer. The method of Hoogstoel would not be appropriate where it is desirable to view the wood substrate, for example, teak components on boats. Rather, the method of Hoogstoel would mask or cover the wood and would not leave it exposed.

In view of the foregoing, it is submitted that Hoogstoel does not anticipate, nor render obvious, claims 1, 8 and 13-14. Withdrawal of the rejection under 35 U.S.C. 102(b) is respectfully requested. The remaining rejections relate to dependent claims (i.e., claims 2-16), which should be allowable if pending claim 1 is found to be allowable.

In view of the above, it is submitted that the application is in condition for allowance. Allowance of claims 1-17 at an early date is solicited.

Respectfully submitted,

August 11, 2003
Date

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